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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Confirmation No. 9008
Shigeru HIRAMOTO et al. : Attorney Docket No. 2004_1149A
Serial No. 10/501,892 : Group Art Unit 1661
Filed July 20, 2004 : Examiner S. McCormick Ewoldt

HELICOBACTER PYLORI ADHESION INHIBITOR

SUPPLEMENTAL RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Response filed on November 2, 2006, there is submitted herewith a copy of the second Official Action in the corresponding Taiwanese application.

Respectfully submitted,

Shigeru HIRAMOTO et al.

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November 29, 2006

THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEE FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975



Your Ref.: PH-2046TW
Our Case No.: 747648
Appln. No.: 092101722
Present Stage: Primary Examination
Type of Notice: Office Action Prior to Rejection
Cited Reference: Y



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[TRANSLATION]

Syllabus:

Upon primary examination, the patent application no. 92101722 is considered as one having something indefinite as stated below in Paragraph 3 of the following Explanation section, and thus should be rejected. If the applicant can provide an argument preferably along with concrete proof that is capable of rebutting the following objection reasons, please prepare and submit to the Intellectual Property Office (IPO) an illustrative response within 60 days from the receipt of this office action. If the applicant's illustrative response is submitted to the IPO after this 60-day period or is groundless, the patent application will be rejected based on the information presently on file.

Explanation:

1. Any supplementation or amendment to the patent application shall be made in accordance with the regulation of Article 48 and 49 of the Patent Law and of Article 28 of the Enforcement Rule of the Patent Law.
2. The applicant may be allowed to come to the IPO for further demonstration or explanation to the Examiner by face to face, for which it should be recited in the applicant's illustrative response that the applicant likes to come to the IPO to have an interview with the Examiner. Nevertheless, the applicant will have the interview with the Examiner at the IPO, only if the Examiner considers it necessary to hold the interview.
3. Upon examination, it was found that
 - (1) for the patent application of invention entitled "Inhibitor of *Helicobacter pylori* adherence", the IPO issued on 14th December 2005 an office action asking the applicant to submit an illustrative response; in response to the office action, the applicant submitted to the IPO on 7th February 2006 an illustrative response



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without making amendment to the specification; thus, the patent application was further examined on the basis of the applicant's illustrative response and the information submitted by the applicant to the IPO for filing; there are totally 14 claims in the claims, wherein claims 1, 4, 5, 10, 11, 13 and 14 are independent claim, while the others are dependent claims;

- (2) the applicant stressed in the illustrative response that the glycoproteins described in the cited references are completely different from the Maillard Reaction product of casein and lactose as disclosed in the present invention, for which the applicant submitted their molecular weight data as a proof for comparison; however, the inhibitor of *Helicobacter pylori* adherence of claim 1 is characterized in that a Maillard Reaction product of sugar and protein is an active ingredient; it should be noted that there are a variety of Maillard Reaction products having different molecular weights, depending upon the different kinds of sugars and proteins participating in reaction; prior art references (see e.g. the attached References 1 to 4) disclosed a variety of Maillard Reaction products having different molecular weights; based on just the description "characterized in that a Maillard Reaction product of sugar and protein is an active ingredient" recited in claim 1 as a technical feature of the claimed inhibitor, it is obvious that in claim 1 there are not concretely set forth the technical features that are requisite for the claimed inhibitor, and the technical content of the specification is inadequate to support that all kinds of Maillard Reaction products of sugar and protein could be used as an active ingredient; claims 1 to 3 fail to meet the regulation of Paragraph 3 and 4 of Article 26 of the Patent Law and Article 18 of the Enforcement Rule of the Patent Law;
- (3) claim 4 relates to a method for producing the inhibitor of claim 1; owing to the fact that the inhibitor of claim 1 fails to meet the requirements for a patent and the Maillard Reaction was well known in the art, the claimed method is devoid of inventive step and hence fails to meet the regulation of Paragraph 4 of Article 22 of the Patent Law; based on the same reasons as stated above, claims 5 to 9 could not be granted for a patent; and,
- (4) based on the same reasons as stated in the above Paragraph (2), claims 10 to 14 relating to a combination composition comprising the inhibitor of claim 1 and



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other well-known agents for combating *Helicobacter pylori* fail to meet the requirements for a patent.